UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,036	11/14/2003	Robert E. Levin	026171.0006	1398

7590 05/18/2007

Thomas F. Bergert
Williams Mullen, PC
Suite 700
8270 Greensboro Drive
McLean, VA 22102

EXAMINER	
JONES, DANELLE E	
ART UNIT	PAPER NUMBER
2626	

MAIL DATE	DELIVERY MODE
05/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/714,036	LEVIN, ROBERT E.	
	Examiner	Art Unit	
	Danelle E. Jones	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19 and 20 of copending Application No. 10713448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 11 and 12 include some the limitations of claims 19 and 20 of copending application 10713448. However the removal of said limitation "from or to a remote communication device" presents a more generic version of claims 19 and 20 of the copending application 10713448. With the

removal of said limitation, the claim is presented in a more generic form and will allow broader coverage.

3. Although the conflicting claims are not identical, they are not patentably distinct from each other because removing inherent and/or unnecessary limitations/step in the claims would be within the level of one of ordinary skill in the art. It is well settled that the omission of a step/element, e.g. "**translating a remote communication.**", and its function is an obvious expedient if the remaining elements/steps perform the same function as before. *In re Karlson, 136 USPQ 184 (CCPA 1963).* Also note Ex parte Rainu, *168 USPQ 375 (Bd. App. 1969).* Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Sadhwani et al. US 2002/0069048.

Regarding **claim 1**, Sadhwani et al. discloses a method of translating speech and delivering it to a communications device (see paragraph [0002]), comprising the steps of:

receiving a request from a first communications device for speech translation services at a server device running a speech translation application (see paragraph [0010] and paragraph [0034]);

retrieving a voice input signal associated with the request from a first communication path (see paragraph [0010] and [0034]);

translating the voice input signal from a source language to a target language message using said speech translation application (see 0033]);

and sending the target language message to a second communications device using a second communication path (see paragraph [0034], where sending the message is separate from the request, thus utilizing a second communication path) , at least a portion of said target language message being revealed audibly via a second device speaker or visibly on a display of said second device (see paragraph [0034]) .

Regarding **claim 2**, Sadhwani et al. discloses the method of claim 1, further disclosing wherein the first communication path is established on a wireless communication network (see paragraph [0029] and [0034], where the communication device can be a mobile phone or the request of the information source can be sent in the form of an email, thus the communication path is on a wireless communication network).

Regarding **claim 3**, Sadhwani et al. discloses the method of claim 1, further disclosing wherein a source language or a target language is automatically determined based on said received request (see paragraph [0040] where the user requests the retrieval of the information and determines the target language).

Regarding **claim 4**, Sadhwani et al. discloses the method of claim 1, further disclosing wherein said speech translation application includes a plurality of first-type translation dictionaries including at least one core language dictionary and a plurality of sub-language dictionaries (see paragraph [0055], where the translations software used the method described).

Regarding **claim 5**, Sadhwani et al. discloses the method of claim 1, further disclosing wherein said speech translation application includes a dictionary search component capable of searching a resource for at least one second-type translation dictionary (see paragraph [0055], where the translations software used the method described).

Regarding **claim 6**, Sadhwani et al. discloses the method of claim 1, further disclosing wherein the request received includes user specific identification information (see paragraph [0039] where the PIN is the users identification information).

Regarding **claim 7**, Sadhwani et al. discloses the method of claim 6, wherein the user specific identification information is used to retrieve user specific files to process the

request for speech translation services (see paragraph [0049], access to personal organizer is user specific information).

Regarding **claim 8**, Sadhwani et al. disclose the method of claim 1, further disclosing wherein the request received from the wireless communication device includes device specific identification information (see paragraph [0038] where T-elink number is the device identifier).

Regarding **claim 9**, Sadhwani et al. discloses the method of claim 8, further disclosing wherein the device specific identification information is used to retrieve user specific files to process the request for speech translation services (see paragraph [0049] where the address book is accessible).

Regarding **claim 10,** Sadhwani et al. discloses a wireless communication system providing speech translation services (see paragraph [0029]), comprising:
a wireless communication device providing voice input for speech translation processing on a first communication path (see paragraph [0029] where a mobile phone can be used as a communication device),
said device also providing sending and receiving party information (see paragraphs [0041], where the user has the option to reply, thus providing the sending information and [0046], where the user has the option to access their own menus;

and a server device running a speech translation application receiving voice input from said wireless communication device on said first communication path (see paragraph [0042]),

converting the received voice input into a text file (see paragraph [0055]),

translating the text file based on determining a language pair from at least one of said sending and receiving party information (see paragraph [0055]),

and sending the translated information to a remote device using a second communication path (see paragraph [0054]).

Regarding **claim 11**, Sadhwani et al. discloses a system for facilitating translation of a communication from or to a remote communication device (see paragraph [0029]), comprising:

a wireless communication device capable of: receiving a translated message; and displaying the translated message on a visual display of the wireless communication device (see paragraph [0029] where a mobile phone is used as the communication device);

and a translation apparatus capable of: receiving a message for translation from a first user, said message including sending and receiving party information and a speech element (see paragraph[0030] and [0033]);

searching a message translation database using at least one of the sending and receiving party identification information to determine a language pair (see paragraph [0055]);

in response to determining said language pair, translating said message speech element from a first language of said language pair to a second language of said language pair (see paragraph [0055]);
and communicating at least a portion of said translated message to said wireless communication device (see paragraphs [0076] –[0080]).

Regarding **claim 12,** Sadhwani et al. discloses the system of claim 11, further disclosing wherein the translation apparatus searches at least one translation dictionary based on said received message (see paragraph [0055]).

Regarding **claim 13**, Sadhwani et al. discloses the system of claim 11, further disclosing wherein said first and second languages of said language pair automatically determined based on said received message (see paragraph [0040] where the user requests the retrieval of the information and determines the target language).

Regarding **claim 16**, Sadhwani et al. discloses the system of claim 11, further disclosing wherein said user is a mobile subscriber (see paragraph [0029] where a mobile phone can be used).

Regarding **claim 17**, Sadhwani et al. discloses the system of claim 11, further disclosing wherein said user is a network operator (see paragraph [0038] where the user is

prompted by an automated operator).

Regarding **claim 20**, Sadhwani et al. discloses the system of claim 11, further disclosing wherein said received message includes device specific identification information (see paragraph [0038] where T-elink number is the device identifier).

Regarding **claim 21**, Sadhwani et al. discloses the system of claim 20, further disclosing wherein said device specific identification information is used to retrieve sender or receiver specific files to translate said message speech element (see paragraph [0049] where the address book is accessible).

Regarding **claim 22**, Sadhwani et al. discloses a system for facilitating translation of a communication from or to a remote communication device, comprising:
a wireless communication device capable of: receiving a translated message; and revealing the translated message via a speaker of the wireless communication device (see paragraph [0029] where a mobile phone is used as the communication device);
and a translation apparatus capable of: receiving a message for translation from a first user, said message including sending and receiving party information and a speech element (see paragraph [0054]);
searching a message translation database using at least one of the sending and receiving party identification information to determine a language pair (see paragraph [0055]);

in response to determining said language pair, translating said message speech element from a first language of said language pair to a second language of said language pair (see paragraph [0055]);

and communicating at least a portion of said translated message to said wireless communication device (see paragraphs [0076] –[0080]).

Regarding **claim 23,** Sadhwani et al. discloses a method of translating speech and delivering it to a wireless communications device (see paragraph [00402]), comprising the steps of:

receiving spoken input from a first wireless communications device at a server device running a translation application (see paragraph [0030] and [0033]);

receiving a signal associated with said spoken input (see paragraph [0054]), said signal corresponding to either a display selection from an interface display on said first wireless communications device or a spoken input received by said first wireless communications device (see paragraph [0075] and [0077]), said signal indicative of a translation request (see paragraph [0054]);

translating the spoken input from a source language to a target language using said speech translation application so as to construct a translated message (see paragraph [0055]), said source language and said target language being determined by input received by said first wireless communications device (see paragraph [0042] and [0054]);

and communicating the translated message to a second wireless communications device (see paragraph [0043] – [0045]), at least a portion of said translated message being revealed audibly via a second device speaker or visibly on a display of said second device (see paragraphs [0052]).

Regarding **claim 24**, Sadhwani et al. discloses the method of claim 23, further disclosing wherein said input for determining said source and target language includes a selection by a user of said first device of source and target languages from a display on said first device display (see paragraph [0042] and [0054]).

Regarding **claim 25**, Sadhwani et al. discloses the method of claim 23, further disclosing wherein said input for determining said source language is sending party information and said input for determining said target language is receiving party information (see paragraph .

Regarding **claim 26**, Sadhwani et al. discloses the method of claim 25, further disclosing wherein said receiving party information is a short code (see paragraph [0054] where the code is a T-elink number).

Regarding **claim 27**, Sadhwani et al. discloses a method of translating speech and delivering it to a wireless communications device, comprising the steps of:

receiving spoken input from a first wireless communications device at a server device running a translation application (see paragraph [0054]);

receiving a signal associated with said spoken input at said server device (see paragraph [0054]), said signal corresponding to either a display selection from an interface display on said first wireless communications device or a spoken input received by said first wireless communications device(see paragraph [0075] and [0077]), said signal indicative of a translation request (see paragraph [0054]);

translating the spoken input from a source language to a target language using said speech translation application so as to construct a translated message(see paragraph [0055]), said speech translation application using at least a core dictionary associated with said source language and said target language (see paragraph [0055], where the translation programs listed use a core dictionary);

and communicating the translated message to a second wireless communications device (see paragraph [0076] – [0080]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14-15 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadhwani et al. US 20020069048 in view of Chong et al. US 5,535,120.

5. Regarding **claim 14,** Sadhwani et al. discloses the system of claim 11 as discussed above, Sadhwani et al. does not disclose wherein said translation apparatus includes a plurality of first-type translation dictionaries including at least one core language dictionary and a plurality of sub-language dictionaries. However this feature is well known in the art as evidenced by Chong et al. Chong et al. discloses a machine translation and telecommunications system that includes a translation apparatus that includes a core language dictionary and a plurality of sub-language dictionaries (see col. 4, lines 8-13). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sadhwani et al. by the teaching of Chong because using a sublanguage dictionary allows for more accurate translations (see col. 4, lines 17-20).

Regarding **claim 15**, Sadhwani et al. discloses the system of claim 11 as discussed above. Sadhwani et al. does not disclose wherein said translation apparatus includes a dictionary search component capable of searching a resource for at least one second-type translation dictionary. However this feature is well known in the art as evidenced by Chong et al. Chong et al. discloses a machine translation and telecommunications system that includes a translation apparatus that includes a core language dictionary and a plurality of sub-language dictionaries (see col. 4, lines 8-13, where the sub-

language dictionary is interpreted as the second-type translation dictionary). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sadhwani et al. by the teaching of Chong because using a sublanguage dictionary allows for more accurate translations (see col. 4, lines 17-20).

Regarding **claim 18**, Sadhwani et al. discloses the system of claim 11 as discussed above. Sadhwani et al. does not disclose wherein said translation apparatus accesses a specialized dictionary of said language pair based on said sending and receiving party information. However this feature is well known in the art as evidenced by Chong et al. Chong et al. discloses a machine translation and telecommunications system that includes a translation apparatus that accesses a specialized dictionary of a language pair based on information sent and received (see col. 4, line 19, where examiner interprets "deemed applicable" as choosing a dictionary based on context on information). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sadhwani et al. by the teaching of Chong because using a sublanguage dictionary allows for more accurate translations (see col. 4, lines 17-20).

Regarding **claim 19**, Sadhwani et al. discloses the system of claim 11 as discussed above. Sadhwani et al does not disclose wherein said translation apparatus accesses a specialized dictionary based on a determined context of said message. However this

feature is well known in the art as evidenced by Chong et al. Chong et al. discloses a machine translation and telecommunications system that includes a translation apparatus that accesses a specialized dictionary of a language pair based on information sent and received (see col. 4, line 19, where examiner interprets "deemed applicable" as choosing a dictionary based on context of the information). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sadhwani et al. by the teaching of Chong because using a sublanguage dictionary allows for more accurate translations (see col. 4, lines 17-20).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danelle E. Jones whose telephone number is 571-270-1241. The examiner can normally be reached on M-F 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 571-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER

DJ
4/26/07